

## REMARKS

This Amendment after Final Rejection and Request for Reconsideration is being submitted in response to the Final Office Action mailed on March 25, 2008.

It is noted that claims 16-23 have been withdrawn from further consideration, so that claims 1-15 remain of record. Claims 1-7 are directed to the seal and claims 8-15 are directed to the method for producing or forming the seal.

The title has been objected to as being non-descriptive. The Examiner has suggested that any references to the method and the device be deleted from the title. However, in view of the foregoing, since only the device claims have been withdrawn, a revised title has been submitted herewith that makes reference to both the vehicle seal as well as the method of forming the same, consistent with the claims of record. It is respectfully submitted that the title proposed by applicant is clearly indicative of the invention to which the claims are directed.

The Declaration has been objected to as being defective because the specification has not been adequately identified. Submitted herewith is a substitute Declaration that properly identifies the subject application.

The drawings have been objected to because Fig. 2 fails to use proper cross-sectional shading, the sections 2 being shown with a cross-sectional shading for metal while these are made of plastic. Fig. 2 has been corrected and a replacement sheet has been submitted herewith that properly depicts the material of which the sections 2 are made, namely plastic. Fig. 2 has also been corrected to show sections 1 as well the sheath 3 to likewise or similarly be formed of a plastic material.

The Abstract of the Disclosure has been objected to as containing terms that the Examiner believes to be confusing, including terms “a flexible reinforcement”, “softer” and “harder”. And certain recitations such as “[sic; section]” on line 20 of page 7 are confusing. The specification has been amended to eliminate such references.

Claims 1-15, 24 and 25 have been rejected under 35 U.S.C. 112, 2<sup>nd</sup> paragraph as being indefinite, for reasons set forth in the first paragraph on page 6 of the Office Action. Additional objections to the claims have been made. The claims have been amended to address the indefiniteness rejections raised by the Examiner. However, applicant respectfully traverses the objection to the expressions “generally soft” and “rigid” in claim 1 and respectfully request the Examiner to reconsider these objections and withdraw the same. Initially, it is a fundamental principal contained in 35 U.S.C. 112, 2<sup>nd</sup> paragraph that applicants are their own lexicographers. They can define the claims by using whatever terms they choose as long as these are not inconsistent with what would be commonly understood by a person skilled in the art unless, of course, any special meanings assigned to a term are clearly set forth in the specification. In this instance, claims 1 and 12 have been amended to clearly define the relative terminology objected to by the Examiner referred to and what the various parameters are compared to. As specified in MPEP § 2173.05 (b), the fact that claim language includes terms of degree that may not be precise does not automatically render a claim indefinite under 35 U.S.C. 112, 2<sup>nd</sup> paragraph. Whether it is indefinite or not generally depends on whether one of ordinary skill in the art would understand the invention and what is claimed, in light of the specification. Thus, “essentially” used to describe the fact that a silicone dioxide source was “essentially” free of alkali metal was held to be definite because the

specification contained sufficient information to enable a person skilled in the art to draw a line between unavoidable impurities and essential ingredients. The Court noted that it would be impractical to require applicants to specify a particular number as a cut-off between their invention and the prior art. *In re Marosi*, 710 F. 2d 799, 218 USPQ 289 (CCPA 1983). The term “substantially” is frequently used in patent claims in conjunction with another term to describe a particular characteristic of the claimed invention. While it is a broadening term, Courts have held the limitation to normally be definite in view of general guidelines contained in the specification. Again, the test is whether it was definite because one of ordinary skill in the art would know what was meant by “substantially” and in light of the overall disclosure. It is respectfully submitted that in the amended claims a person of ordinary skill in the art of designing and manufacturing vehicle seals would understand and know what a generally rigid non-metallic material would be used for the second individual sections and what a generally soft elastic material should normally be for the first individual sections, especially in light of the teaching that the two materials have different hardnesses, with the second material having a hardness greater than the hardness of the first material used for the first sections. Clearly, there is nothing in the subject application that makes it a critical feature of the invention the specific hardnesses used. Instead, a person skilled in the art would understand that the materials generally used in making seals of this type are selected from materials having hardnesses within certain ranges for reasons of functionality, costs, etc. The claimed novelty is clearly not the fact that specific hardnesses of the two materials forming the first and second sections are used but that the first and second sections that are assembled in the manner disclosed and claimed have different hardnesses with one of the sections

being softer to render it flexible or deformable and the other being harder to render it rigid and dimensionally stable. With such teaching, it is respectfully submitted that a person skilled in the art would immediately understand what the invention is and how to make and use the invention. Accordingly, it is respectfully submitted that claims 1 and 8, are particularly as amended, not indefinite under 35 U.S.C. 112, 2<sup>nd</sup> paragraph and reconsideration and withdrawal of this rejection is respectfully requested. It is respectfully submitted that all of the claims currently of record particularly point out and distinctly claim the subject matter that applicant regards as the invention.

Claims 1-3, 5-9, 12-15, 24 and 25 have been rejected as being fully anticipated by U.S. Patent No. 4,676,856 to Shigeki et al., for reasons set forth in the paragraph bridging pages 6 and 7 of the Office Action. Claims 4, 10 and 11 have been rejected as being obvious on the basis of Shigeki et al. when further combined with secondary references, for reasons set forth in the first two paragraphs on page 8 of the Office Action. In making these prior art rejections, the Examiner has indicated that he has fully considered the arguments submitted on March 26, 2007 but has not deemed these to be persuasive for reasons set forth starting on the bottom of page 8 of the Office Action through and ending on page 9 of the Office Action. In a subsequent telephone conference with the Examiner, Shigeki et al. was discussed and proposed revisions to the claims were likewise discussed. During this telephone conference, the Examiner also noted that he was aware of another potential reference, U.S. Published Patent Application No. 2002/0092242 which is an application filed by Kounobu et al. on August 21, 2007. Initially, applicant notes that Kounobu et al. was filed on September 30, 2004, well after the August 27, 2003 filing date of the subject application. In fact, the earliest foreign priority claimed by

Kounobu et al. is October 6, 2003 based on a Japanese patent application which likewise bears a date subsequent to the U.S. filing date of the subject application of August 27, 2003. Accordingly, it is not understood how Kounobu et al. could be a reference against the subject application. However, the Kounobu et al. publication, besides being moot, is also irrelevant for reasons to be discussed in connection with the applied Shigeki et al. Patent as a primary patent.

Shigeki et al. teaches a weather strip for vehicles. In all of the embodiments disclosed in Shigeki there are disclosed continuous strips of metal, such as by stamping, that are joined to each other as suggested in Figs. 4, 13, 16 and 18. Thus, the individual elements forming the core member 14 continue to be joined or connected to each other as shown. The slots or spaces formed between the individual segments are initially filled with air but then presumably filled with rubber forming the outer sheath 11 that fills the grooves or recesses. Similarly, in Kounobu et al. a continuous strip of joined segments are disclosed in which the individual segments are connected to each other by means of a spline as shown, for example, in Figs. 9 and 10 of this uncited reference.

On the basis of the teachings in the aforementioned references, as well as the telephone conference with the Examiner, claims 1 and 8 have been amended to more clearly specify that the flexible reinforcement is formed of U-shaped first and second sections with one of these being generally soft and the other being generally rigid. The claims now clearly specify that successive first sections are fully separated from each other by adjacent second sections and likewise successive second sections are fully separated from each other by adjacent first sections. There is no continuity, therefore, between successive first sections or between second sections to each other. Instead, the

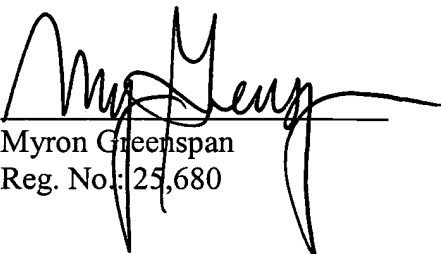
first sections fully separate the second sections and the second sections fully separate the first sections to provide both flexibility along the seal as well as the ability to securely grip and retain a member of the automobile. Such construction is not disclosed or even remotely suggested in either Shigeki or in Kounobu et al. It is respectfully submitted that the claims as amended clearly and patentably distinguish over the applied as well as the unapplied references. Reconsideration of the full anticipation rejections is, therefore, respectfully requested. Claims 4, 10 and 11 depend directly or indirectly on presumably allowable claims and, therefore, should be allowed with the allowance thereof.

This application now appears to be in condition for allowance. Early allowance and issuance is, accordingly, respectfully solicited. If the Examiner persists in any of the outstanding rejections it is respectfully requested that this application be entered at least for purposes of Appeal. If the Examiner has any questions or wishes to discuss any of the aforementioned or discuss any further proposed revisions to the specification and/or claims a call from the Examiner to the undersigned attorney for applicant would be appreciated.

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